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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,112	03/01/2000	Hiroyuki Fujiyoshi	862.C1854	3021

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NEW YORK, NY 10112

EXAMINER
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JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 03/23/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/516,112	<b>Applicant(s)</b> FUJIYOSHI, HIROYUKI	
	<b>Examiner</b> Bunjoo Jaroenchonwanit	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-26,28-46 and 48-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 8-26,28-46 and 48-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to communication filed 2/19/04, A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/19/04 has been entered.
2. Claims 1-6, 8-26, 28, 46, 48-66 and 68-94 are pending for examination, the rejection cited as stated below.
3. The text of those sections of Title 35, U.S. Code § 102 (e) and 103 (a) not included in this action can be found in a prior Office Action.
4. Claims 1-4, 6, 8-10, 16-24, 26, 28-31, 37-44, 46, 48-50, 56-64, 66, 68-71 and 77-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai et al (US.6, 466,968) and Uchida et al (US. 6,327,610).
5. Claims 5, 11-15, 25, 32-36, 45, 52-55, 65 and 72-76, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai-Uchida, as applied to claims 1, 10, 20, 41, 50 and 60 above, and further in view of Holtz (US. 6,433,800).
6. As to claims 1, 21, 41, 61 and 93, Shirai discloses means, steps and instructions for generating an attached file (Fig. 22, 301c, Fig. 20, S54, Col. 12, 25-32) (*i.e., a designating step of designating a desired object to be attached to electronic mail*). Further, Shirai discloses a means, steps and instructions for a designator unit for designate access method (Fig. 22, 301i; Col. 13, lines .42-44) (*i.e., an acquisition step of acquiring access information relating to the*

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*object designated at said designating step*). Furthermore, Shirai discloses a means, steps and instructions for including access information in the e-mail messages, for using as instruction, by e-mail recipient, to access and/or handling the attachment file (Fig. 4, 19; Col. 5, lines 43-52; Col. 12, lines 32-40) (*i.e., mail information generating step of generating electronic mail information in which the access information acquired at said acquisition step constitutes part of the electronic mail*). Shirai does not explicitly disclose, an inclusion of access information that permitting users to access objects in a storage, as pointed out by the applicant in the remark and supported by the specification in page 10, lines 4-8. In light of the supported passage, applicant referred to the use of access key, which is sent to email recipients for accessing objects stored in a corresponding storage. In the same field of endeavor, Uchida teaches a system for delivery objects via emails delivery mechanisms, to avoid consuming large amount of network bandwidth, which usually occurred when a large object is delivered via email attachment conventionally, which often caused problems in delivering emails and their attachments. Uchida, rather than employing conventional technique, attachment objects directly to emails, motivated by the aforementioned problems, therefore, Uchida embedded an access code, *i.e.*, access key, access information, in an email and delivered the email to a corresponding recipient. The email recipient then used the access code to access a corresponding stored object (Col. 3, lines 2-6; Col. Fig. 3, 306; Fig. 4, 412-415). Thus, whoever received an access code would be able to access the corresponding object, regardless of registering for accessing the object. Thus, taking advantage from Uchida's teaching, to improve Shirai's system, to reduce increasing cost from network bandwidth consumption, would have obvious to one of ordinary skill in the art at the time of the invention was made. Because such improvement would enable one to control

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amount of e-mail transmission over the network, preventing enormous traffics, especially traffics generated from e-mails attachments, thereby minimizing utilization and operation cost let alone further strengthen e-mail security and user privacy.

7. As to claims 2, 22, 42 and 62, Shirai-Uchida discloses means, steps and instructions for generating attachment file and designating access method (Shirai, Col. 5, lines 43-56) (*i.e., mail information generating step generates an attachment file which includes the access information acquired by said acquisition step and attaches the generated attachment file to electronic mail that is to be transmitted*).

8. As to claims 3, 23, 43 and 63, Shirai-Uchida discloses means, steps and instructions for merging an attachment file and access method into e-mail message (Shirai, Col. 5, lines 57-61) (*i.e., said mail information generating step affixes the access information, which has been acquired at said acquisition step, to a main body of electronic mail that is to be transmitted*).

9. As to claims 4, 24, 44 and 64, Shirai-Uchida discloses means, steps and instructions for generating an URL for accessing an attachment file (Shirai, Fig. 4B; Col. 5, lines 56-58) (*i.e., the access information includes information indicating a storage location of the object, which has been designated at said designating step, in the system*).

10. As to claims 6, 26, 46 and 66, Shirai-Uchida discloses means, steps and instructions for allowing e-mail users to set access method via e-mail attached file edit window (Shirai, Fig. 19; Col. 4, lines 52-53) (*i.e., acquisition step includes a setting step of allowing a user to set access information via a prescribed user interface*).

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11. As to claims 8-9, 18-19, 28-29, 39, 40, 48-49, 58, 59, 68-69 and 79-80, Shirai-Uchida discloses attachment access information includes an access key for logging in the storage location (Uchida, Col. 3, lines 2-6; Col. Fig. 3, 306; Fig. 4, 412-415).

12. As to claims 16, 17, 56, 57, 37, 38, 77 and 78, Shirai-Uchida discloses means, steps and instructions for extracting access method (Shirai, Col. 20, lines 8-9) (*i.e., said extraction step extracts the access information from a file that has been attached to electronic mail*).

13. As to claims 10, 31, 50, 71 and 94, in addition to claim 1, Shirai-Uchida discloses the system includes means, step and instructions for: *an extraction step of extracting the access information contained in electronic mail that has been received* (Shirai, Col. 14, lines 50-51); *an object access step of accessing an object based upon the access information extracted at said extraction step* (Shirai, Col. 14, lines 52-53); and *a display step of presenting a display that corresponds to the object based upon a content of the object accessed at said access step* (Shirai, Col. 15, lines 40-45).

14. As to claims 20 and 60, in addition to claim 1, Shirai-Uchida an apparatus, a method steps and sets of computer instructions (hereinafter a “system”) for construction and communication e-mails and their attached files (See abstract and claims). The system comprising means, steps and instructions for generating e-mails, including attachment files and instructions how to access the attachment files (*i.e., a generating step of generating electronic mail information which includes access information relating to an object to be attached to electronic mail*) (Shirai, See Fig. 4A, 401-405; Fig. 4B, 407-408; Fig. 5, S11-S14); means, steps and instructions for communicating the e-mails and the attachment files (*i.e., a communication step of sending and receiving the electronic mail information generated at said generating step*)

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(Shirai, Fig. 3B, 301b, 302305, 306b; Fig. 5, S16; Fig. 6, S24); *and* means, steps and instructions for access the attachment files based on the access information (Shirai, Fig. 4, 405, 407-408; Fig. 6, S25), *(i.e., an access step of accessing the object based upon the access information contained in the electronic mail information received via said communication step)*.

15. As to claims 30, 70, Shirai-Uchida discloses means, steps and instructions for transmitting e-mail, attachment and other desirable information to e-mail recipients (Shirai, Fig. 1, 103-104) *(i.e., communication step transmits the electronic mail information, which has been generated at said generating step, to an information processing apparatus that has been designated)*.

16. As to claims 81-92, as discussed in the above paragraphs, Shirai-Uchida-Uchida discloses the invention substantially, as claimed, including attachment access information, sending access code to subscribers, i.e., registered users, and preventing non subscribers to access the information, by sending access code to its subscribers only. Shirai-Uchida-Uchida does not explicitly disclose *setting whether or not to provide the access information, password, to unregistered user*. However, having a system to decide whether or not to send access information to a specific users, e.g., unregistered, would have been obvious to one of ordinary skill in the art at the time of the invention was made that was a matter of design choice that clearly depended on applications' requirements. Because allowing sending access information to all users, (e.g., subscribers and non-subscribers), the system would capable of sending e-mails to new users, which could be used and most required for advertising and products marketing.

17. As to claims 5, 11-15, 25, 33-36, 45, 51-55, 65 and 72-76, Shirai-Uchida discloses the invention substantially as claim but fails to disclose *a thumbnail of documents, and displaying an*

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*icon corresponding to an electronic mail application; and designating a desired by dropping the document on to the icons.* However, in an analogous art, to improve over a conventional system (Holtz, Col. 2, lines 28-52), Holtz teaches a graphical method invocation method, and associated method for computer system, which capable of displaying list of e-mails and attached objects in at a glance form, icons, and capability of allowing objects to be designated to the icons and list by way of drag and drop (Holtz, Fig. 2, items 54, 44, 46 and 48; Col. 25, lines 3-16; Fig.6-8 and corresponding details in Col. 6, line 62-Col. 7, line 40). Thus, taking advantage of Holtz suggestions would have been obvious to one of ordinary skill in the art at the time of the invention was made. Because, it would enable users to easily select and/or view multiple attached objects in a short time and less interventions from the users, thereby, increasing users' conveniences and the system could be more attractive to the users.

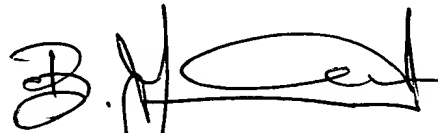
18. Applicant's arguments filed 2/19/04 have been considered but are moot in view of the new ground(s) of rejection.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a stylized flourish at the end.

Bunjob Jaroenchonwanit  
Primary Examiner  
Art Unit 2143

/bj